

REMARKS

Status of the Application

Claims 1-9 are currently pending. Claims 10-20 have been withdrawn in response to a restriction requirement. Claims 1-2 are rejected for formal reasons under 35 U.S.C. Section 112, First and Second Paragraphs. Claims 1-9 are rejected under the Judicially Created Doctrine of Obviousness-Type Double Patenting. There are no pending art rejections.

Applicants request entry of the following amendment to claim 1 to place the application in condition for allowance. Specifically, step b) of claim 1 is amended to remove the phrase "and wherein said target-specific polynucleotide specifically hybridizes to the test sample". No new matter has been added as a result of this amendment to claim 1.

Also submitted herewith is a terminal disclaimer to overcome the obviousness-type double patenting rejection.

Rejection of Claims 1 and 2 Under 35 U.S.C. Section 112, First and Second Paragraphs

Claims 1 and 2 are rejected under 35 U.S.C. Section 112, first and second paragraphs. With respect to the 35 U.S.C. Section 112, first paragraph rejection, the Examiner states that the added claim limitation in step b) of claim 1, namely, the phrase "wherein said target-specific polynucleotide specifically hybridizes to the test sample", is not supported by the specification and claims as originally filed. With respect to the 35 U.S.C. Section 112, second paragraph rejection, the Examiner says that the claims are indefinite. In connection with this rejection, the Examiner says that (a) there is insufficient antecedent basis for the phrase "said target-specific polynucleotide"; and (b) with respect to the phrases "a method of detecting the presence of prostate cancer associated (PS112) polynucleotide in a test sample" and "wherein said target-specific polynucleotide specifically

hybridizes to said test sample” it is unclear if the target-specific polynucleotide is hybridizing to the test sample itself, or the PS112 polynucleotide in the test sample. Applicants respectfully traverse this rejection.

While not agreeing with the Examiner’s rejection, in order to place the application in condition for allowance, Applicants have amended step b) of claim 1 to remove the phrase “and wherein said target-specific polynucleotide specifically hybridizes to said test sample”. Applicants submit that the deletion of the above mentioned phrase resolves all issues (new matter, antecedent basis and clarity) raised by the Examiner under paragraph 112. Thereupon, Applicants submit that these rejections are now moot and should be withdrawn.

Rejection of Claims 1-9 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

Claims 1-9 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,110,675. Applicants respectfully traverse this rejection.

While not agreeing with the Examiner’s rejection for obviousness-type double patenting, Applicants herewith submit an executed terminal disclaimer to overcome this rejection. Applicants submit the fee for filing the terminal disclaimer is One Hundred Thirty Dollars (\$130.00). In view of the submission of this terminal disclaimer and the requisite, Applicants submit that this rejection is now moot and should be withdrawn.

CONCLUSION

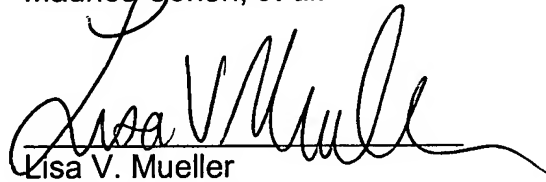
Applicants respectfully submit that all rejections have been overcome and the application is in condition for allowance, which action is respectfully requested.

Should the Examiner have any questions concerning the above, she is respectfully requested to contact the undersigned at the telephone number listed below. If the Examiner notes any further matters which the Examiner believes may be expedited by a telephone interview, the Examiner is requested to contact the undersigned.

Applicants submit that no additional fees are required. However, if any additional fees are required or incurred as a result of the filing of this paper, authorization is given to charge deposit account no. 23-0785.

Respectfully submitted,

Maurice Cohen, *et al.*

A handwritten signature in black ink, appearing to read "Lisa V. Mueller", written over a horizontal line.

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